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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/977,306

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Shinichi Yada

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ALEXANDRIA, VA 22320

EXAMINER

WOO, ISAAC M

ART UNIT

PAPER NUMBER

2166

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

09/977,306

**Applicant(s)**

YADA, SHINICHI

**Examiner**

Isaac M. Woo

**Art Unit**

2166

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 23-27 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 28-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 19, 2007 has been entered.

2. Claims 1-3, 12-13, 28 and 30 are amended. Claims 23-27 and 31 are withdrawn. Claims 1-22 and 28-30 are presented for this office action.

### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-22 and 28-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As set forth in MPEP 2106 (II) (A):

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A. Identify and Understand Any Practical Application Asserted for the Invention

The claimed invention as a whole must accomplish a practical application. That is, it must produce a "useful, concrete and tangible result." *State Street*, 149 F.3d at 1373, 47 USPQ2d at 1601-02. The purpose of this requirement is to limit patent protection to inventions that possess a certain level of "real world" value, as opposed to subject matter that represents nothing more than an idea or concept, or is simply a starting point for future investigation or research (*Brenner v. Manson*, 383 U.S. 519, 528-36, 148 USPQ 689, 693-96); *In re Ziegler*, 992, F.2d 1197, 1200-03, 26 USPQ2d 1600, 1603-06 (Fed. Cir. 1993)). Accordingly, a complete disclosure should contain some indication of the practical application for the claimed invention, i.e., why the applicant believes the claimed invention is useful.

Apart from the utility requirement of 35 U.S.C. 101, usefulness under the patent eligibility standard requires significant functionality to be present to satisfy the useful result aspect of the practical application requirement. See *Arrhythmia*, 958 F.2d at 1057, 22 USPQ2d at 1036. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make the invention eligible for patenting. For example, a claim directed to a word processing file stored on a disk may satisfy the utility requirement of 35 U.S.C. 101 since the information stored may have some "real world" value. However, the mere fact that the claim may satisfy the utility requirement of 35 U.S.C. 101 does not mean that a useful result is achieved under the practical application requirement. The claimed invention as a whole must produce a "useful, concrete and tangible" result to have a practical application.

Regarding claims 1-3, 12-13, 28 and 30, the claimed invention limitation ends with "deleting the information after having checked the condition", which does not provide any tangible and real world application. Therefore, the claims (1-22 and 28-30) are not a statutory system and should be rejected under 35 U.S. C. § 101 as not being tangible.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-22 and 28-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Mahoney et al (U.S. Patent No. 5,659,639, hereinafter, "Mahoney").

With respect to claims 1-3, 12-13, 28 and 30, Mahoney teaches image feature extracting means for extracting a feature of the image based on an instruction from a client, the feature associated with electronic information stored in storing means connected to a network (col. 25, lines 40-51), (col. 30, lines 31-40, col. 38, lines 34-42); deciding means for deciding whether the electronic information is to be deleted based

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on the feature extracted by the image feature extracting means and on a condition specified by the client (col. 22, lines 4-13, col. 35, lines 60-67 to col. 36, lines 1-7); and deleting means for deleting from the storing means via the network and via a deletion method specified by the client unnecessary electronic information decided to be deleted by the deciding means, the deleting means includes means for deleting information that matches a predetermined condition and means for deleting the information after having checked the condition (col. 22, lines 4-13, col. 35, lines 60-67 to col. 36, lines 1-7).

With respect to claims 4 and 14, Mahoney teaches extracted feature is at least one of an aspect ratio of the image, a color distribution information, a brightness distribution information of the image, and an edge distribution information of the image (col. 22, lines 4-13, col. 35, lines 60-67 to col. 36, lines 1-7, col. 4, lines 12-40).

With respect to claims 5 and 15, Mahoney teaches decides whether the electronic information is to be deleted based on the client-specified condition including a condition that a first symbol encoded in the image corresponds to a second symbol associated with the electronic information (col. 22, lines 4-13, col. 35, lines 60-67 to col. 36, lines 1-7).

With respect to claims 6 and 16, Mahoney teaches decides whether the electronic information is to be deleted based on a feature of a second image similar to the image (col. 22, lines 4-13, col. 35, lines 60-67 to col. 36, lines 1-7, col. 2, lines 6-63).

With respect to claims 7 and 17, Mahoney teaches decides that other electronic information related to specific electronic information is also deleted together with the specific electronic information decided to be deleted based on the feature (col. 22, lines 4-13, col. 35, lines 60-67 to col. 36, lines 1-7, col. 2, lines 6-63).

With respect to claims 8 and 18, Mahoney teaches temporarily storing electronic information sent via a network, wherein the deleting means deletes the unnecessary electronic information stored in the temporarily storing means at a predetermined timing (col. 22, lines 4-13, col. 35, lines 60-67 to col. 36, lines 1-7).

With respect to claims 9 and 19, Mahoney teaches deletes the unnecessary electronic information from the temporarily storing means after a predetermined period of time has elapsed (col. 22, lines 4-13, col. 35, lines 60-67 to col. 36, lines 1-7).

With respect to claims 10 and 20, Mahoney teaches instructing and operating means for instructing a feature associated with the electronic information to be deleted (col. 22, lines 4-13, col. 35, lines 60-67 to col. 36, lines 1-7, col. 4, lines 12-40).

With respect to claims 11 and 21, Mahoney teaches inputting the feature and transferring it to the instructing and operating means (col. 14, lines 60-67 to col. 15, lines 1-67).

With respect to claim 22, Mahoney teaches inputting a feature associated with the electronic information to be deleted; and giving a deletion execution instruction to unnecessary electronic information that is to be deleted and extracted from the storing means according to the input feature (col. 2, lines 6-63).

With respect to claim 29, Mahoney teaches storing electronic information sent via a network in temporary storing means; deleting unnecessary electronic information stored in the temporary storing means at a predetermined timing (col. 4, lines 12-40).




**Conclusion**

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac M. Woo whose telephone number is (571) 272-4043. The examiner can normally be reached on 8:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain T. Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Isaac Woo  
May 23, 2007